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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,698	12/14/1999	STUART KAMILLE	03004.P007	4156

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/28/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,698

Applicant(s)

KAMILLE, STUART

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 96-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 96-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3622

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-31 and 96-100 in Paper No. 5 is acknowledged.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference numbers mentioned in the description. For example, the second paragraph in p. 6 refers to Fig. 1a describing a coupon 100 comprising a first field 110 and a second field 140. The reference numbers 100, 110 and 140 are missing from Fig. 1a. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-10 and 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the second field" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "scoring" in claims 25-31 is used by the claim to mean "targeting," while the accepted meaning is "to grade" (Merriam-Webster Collegiate).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-24 and 96-100 are rejected under 35 U.S.C. 103(a) as being obvious over Lawlor et al. in view of Halliburton, Jr.
7. Lawlor et al. teaches (independent claims 1, 14 and 96) a method of delivering and targeting an advertisement, and an advertisement so delivered and targeted, the method comprising: selecting a response (e.g., identifying the user) in a first field (col. 25 lines 5-10 and col. 30 lines 47-50), which is any of the four fields taught (col. 23 lines 44-54), including at least one request (col. 30 lines 47-53) and at least one response, respectively on backlit LED and on LCD screens (col. 24 lines 39-56 and col. 23 lines 34-41), which reads on "on top of a removable concealer"; *microcontroller 116* executing program control instructions in response to the selection of a response in the first field (i.e., depressing *input controls 104-114*. col. 27 lines 56-58 and Fig. 4), producing a request to identify the *bank account* (col. 30 lines 51-53), which reads on removing the removable concealer to reveal information (the request for *bank account*) indicating an area of a second field (*input controls 104-114* corresponding to one of the four LCD fields where the *bank account* request appears) to select; *microcontroller 116* again executing program control instructions in response to the selection of a response in the second field (i.e., depressing *input controls 104-114*. col. 27 lines 56-58 and Fig. 4), producing a request to enter an ATM PIN (col. 30 lines 56-59), which reads on revealing information by removing additional removable concealer from the indicated area of the second field. Lawlor et al. also teaches (claim 96) downloading information of use to the user (col. 26 lines 20-29).
8. Lawlor et al. does not teach that the request for information is a question. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that any declarative

Art Unit: 3622

request for information, e.g., "identify the user", is implicitly a question, i.e., "who is the user?". Alternatively, because the interrogative form is more polite and would therefore appeal to more customers than the declarative form, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to phrase the request as a question.

9. Simply restated, Lawlor et al. teaches presenting questions and answers on backlit LED and on LCD screens, which contain fields, using response keys 104-114 to choose responses and automatically call the next set of questions and answers, which reads on removing a concealer and revealing information.
10. Lawlor et al. does not teach that the advertisement is a coupon. Halliburton, Jr. teaches that the advertisement is a coupon (col. 1 lines 47-55). Because a targeted coupon can be expected to be more attractive to the customer than a non-coupon advertisement, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Halliburton, Jr. to those of Lawlor et al.
11. Lawlor et al. also teaches claims 2-7, 9, 11-13, 15-18 and 21-24 at the citations given above.
12. Neither of the references teach (claims 8, 10, 19 and 20) that revealing information includes a symbol or a form. Lawlor et al. does teach a standard keypad 114 including the symbols/forms "*" and "#" (col. 12 line 28). Because these symbols/forms are well known to users as convenient shorthand, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include them in some revealing information messages.
13. Lawlor et al. does not teach or suggest (claims 97-100) printing and limiting the downloaded information. Halliburton, Jr. teaches printing and limiting the downloaded information (col. 2 lines 35 and 67-68). Because printed coupons are still more widely accepted than electronic coupons, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the ATM printing feature taught by Halliburton, Jr. to the teachings of Lawlor et al.

Allowable Subject Matter

14. Claims 25-31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3622

15. The following is an examiner's statement of reasons for the indication of allowable matter for independent claim 25: the closest prior art, Kamille ('997 patent), does not teach or suggest scoring (targeting) a coupon and does not teach or suggest having at least one question and at least one answer on top of a removable concealer. The reference does teach movable concealers over first and second fields (first or upper and second or lower "tiers", col. 8 lines 49-67 with reference to Fig. 4A & 4B). What is lacking is the question and answer over either of the concealers and the application to a "coupon". The meaning of coupon, as an instrument for a discount, is made clear by the specification, notably at p. 2 lines 10-15 and by Fig. 1a-1b and 2a-2b.
16. The reference teaches scoring a game instrument. It would not be obvious to one of ordinary skill in the art to apply that teaching to scoring (targeting) a coupon. Although the reference mechanism is very similar to the claimed mechanism, the gaming and coupon arts are sufficiently different so as to make it non-obvious to apply the reference to coupons. Furthermore, the question and answer format is integral to the instant invention. Its absence from the reference only makes the reference less obvious for the targeting of a coupon.
17. One older Kamille patent (US 4,756,532) teaches a question and answer format for a promotional game, and another older Kamille patent (US 4,964,642) teaches a promotional game with removable concealer. However, even together they do not suggest putting both the question(s) and answer(s) on top of a removable concealer, and they do not suggest a coupon.
18. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.

Art Unit: 3622

20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9235.

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
Art Unit 3622

18 June 2002